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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/804,626 | 03/09/2001 | Leslie Lobel | 62259/JPW/SHS | 5559 |

7590 07/26/2004

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EXAMINER

JIANG, DONG

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1646

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/804,626

Applicant(s)

LOBEL ET AL.

Examiner

Dong Jiang

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1, 2, 4, 7, 16, 18, and 24-26.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: No amendment accompanied the request for reconsideration.

Lorraine Spector
LORRAINE SPECTOR
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: Claims 1, 2, 4, 7, 16, 18, and 24-26 will remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hsueh et al., US5,925,549, and McCoy et al., US5,270,181, for the reasons of record set forth in the Office Actions mailed on 05 December 2003, and on 06 April 2004.

Applicants argue in the response filed on 07 June 2004 that the Examiner's rejection is improper because of the absence of a showing a motivation to combine by either reference as MPEP indicates that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Applicants further argue that the art failed to provide the combination of references during the 8 years following the McCoy patent, highlighting the non-obviousness of the claimed invention. Applicants argument has been fully considered, but is not deemed persuasive because MPEP states that there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teaching of the prior art (cited by applicants), and the knowledge of persons of ordinary skill in the art. In the instant case, although neither reference explicitly suggests to combine the teaching with the other, based on the teachings of each of the two references, and the knowledge of persons of ordinary skill in the art, a person of ordinary skill in the art would be motivated to combine them to arrive at the claimed fusion protein because of the advantages taught by McCoy that such fusion protein is stable, soluble and expressed at high level, and that the resulted fusion protein is useful as a therapeutic without cleavage.

With respect to the argument in lack of progress in the field for 8 years, such is not an evidence for patent novelty or lack of obviousness. Applicants have not provided any additional fact or evidence to overcome the rejection.